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EXAMINER

MCGUTHRY BANKS, TIMA M

ART UNIT	PAPER NUMBER
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1742

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13

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

13
Paper No. 44

Application Number: 09/350,858
Filing Date: July 09, 1999
Appellants: CHU ET AL.

Douglas G. Glantz
For Appellant

MAILED

JAN 25 2002

GROUP 1700

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8 January 2002.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

Art Unit: 1742

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because the appellants state that the invention provides a novel *method*. The present application involves an independently claimed *product*. Claim 18, the only independent claim, does not provide for any process limitations. Claim 19, a dependent claim, provides for a final product made by a claimed method.

(7) *Grouping of Claims*

Appellant's brief includes a statement that Claims 18, 20-23, and 25 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Art Unit: 1742

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,915,908

NAGLE et al

04-1990

(10) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claims 18, 20, and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagle et al (US 4,915,908). Nagle anticipates the claimed invention. Nagle teaches a method for the production of a composite comprising a distribution of second phase particles in a metal, metal alloy, or intermetallic final matrix. The method comprises the following steps:

- a) preparing a mixture of elemental powders and a substantially non-reactive solvent metal,
- b) adding the mixture to a molten metal matrix, metal alloy, or intermetallic, and
- c) forming the composite by the diffusion and reaction of the mixture (Claim 1).

The solvent metal and the molten matrix metal comprise aluminum or alloys of aluminum (Claim 8). The particulate second phase includes zirconium carbide (Claim 16). Example 5 in column 7 demonstrates the ability to disperse titanium carbide second phase particles throughout an aluminum final matrix. Nagle also teaches that the particle size is from less than about 0.01 to about 0.5 microns (column 13, lines 63 and 64). Examples of the second phase ceramic precipitates are carbides and include molybdenum, niobium, vanadium, and scandium (column 8, lines 58-62).

Art Unit: 1742

Claim 19 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nagle. Nagle teaches the invention substantially as claimed. Though Nagle teaches that the particle size is from less than about 0.01 to about 0.5 microns (column 13, lines 63 and 64), Nagle does not disclose the step of providing a chloride salt as claimed. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 195 USPQ 430, 433 (CCPA 1977). Applicants state on page 9, lines 5-7 of the specification that the salt is decanted or removed after the reaction occurs to produce the carbide particles. Therefore, the final product taught in Nagle reads on the claimed product.

(11) Response to Argument

Regarding Claims 18, 20-23, and 25, appellants state that Nagle does not teach using carbides of Sc, V, Mo, or Nb. However, Nagle does teach using all of these metals in carbides in column 8, lines 58-67.

Regarding Claim 19, appellants argue that the process by which the product is made in Nagle is different than in the present invention. However, the claim is drawn to a final product, not the process by which it is made. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 195 USPQ 430, 433 (CCPA 1977). Additionally, appellants argue that the properties

Art Unit: 1742

of the claimed product-by-process, namely the volume percent, the density, and the closeness of particles upon 500-x magnification, were not claimed and were not presented as arguments before the claim was finally rejected. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



tmm

January 24, 2002

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